

Remarks

Claims 1-39 are pending in the application. All claims stand rejected. By this paper, claims 2, 5-9, 11, 12, 17, 18, 21, 24-28, 30, 31, 36, 37, and 39 have been canceled. Reconsideration of remaining claims 1, 3-4, 10, 13-16, 19, 20, 22, 23, 29, 32-35, and 38 is respectfully requested.

In view of the claim cancellations and amendments, rejections under 35 U.S.C. § 102(e) and some previous rejections under 35 U.S.C. § 103(a) are now moot.

Claims 12, 19, 31, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,654,050 to Karube et al. ("Karube") In view of U.S. Patent No. 6,606,081 to Jaeger et al. ("Jaeger"). Independent claims 1 and claim 20 have been amended to include the limitations of their depending claims 11, 12 and 30, and 31, respectively.

All Claim Limitations Are Not Taught by the Prior Art

Independent claims 1, 19, 20, 38 have been amended to recite first and second magnets having a magnetic force and that the magnetic force alone secures the second magnet to the display. The applicants respectfully submit that these claimed limitations are not taught or suggested by cited references.

Jaeger discloses "moveable magnetic devices for use in conjunction with electronic displays." Col. 1, lines 58-60. Jaeger also states that it is a salient feature to drive the fader cap to any position along the track. Col. 2, lines 10-12. In reference to Figures 11 and 12, Jaeger teaches the use of opposing magnets 84, 87

and a structural assembly 83 to provide slidable movement of a fader cap controller or a fader cap 86. "The magnet may be permanent or electromagnetic, and is mounted for sliding translation on the assembly 83." Col. 7, lines 53-55. "In the embodiment of FIG. 11, the fader cap controller is received in a channel-like groove in smoothly sliding fashion, whereby translation of the cap is guided in a linear direction." Col. 7, lines 61-64. "In the embodiment of FIG. 12, the fader cap 86 is slidably received on the surface of the superstrate or flat panel display, and is guided manually in accordance with a graphic presentation on the flat panel display." Col. 7, line 64 to col. 8, line 1. Slidable movement is enabled by the structural assembly 83, embodiments of which are disclosed in reference to Figures 13 and 14.

The apparatus of the claimed invention does not require a structural assembly to support and secure the second magnet. The second magnet is secured only by its magnetic coupling to the first magnet. In Jaeger, the second magnet must be secured to a screen in order to enable slidable translation. The frictional resistance from sliding a magnet is likely to overcome a magnetic field. Otherwise, Jaeger would have no need of the disclosed structural assembly.

In the present invention, the magnets remain stationary until completely removed from a display. Slidable movement of the magnets is not enabled or desired. A camera is to remain stationary in a disposed eye-level location in order to provide efficient and ergonomic performance. The devices disclosed by Jaeger and the present invention are to address different problems. Jaeger's solution is more costly to implement, may present problems with respect to retrofitting an preexisting thin panel display, but does enable slidable movement. The present invention is

relatively inexpensive, is easy to use on any thin panel display, but does not allow slidable movement.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03. As the limitation of a magnetic field alone securing a second magnet to a display is not taught or suggested by the prior art references, a prima facie case of obviousness does not exist.

No motivation to combine

Karube and Jaeger provide no motivation to combine the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680 (Fed. Cir. 1990). Even if all the elements of claim are disclosed in the various prior art references, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the references to arrive at the claimed invention.

Jaeger discloses a device to enable slidable movement. Slidable movement is in contrast to Karube which teaches a fixed position for a camera. The slidable magnet mechanism of Jaeger further requires the structural assembly in order to overcome the frictional resistance of the magnetic coupling. There is no impetus to combine a stationary camera mount of Karube with a slidable device of Jaeger.

Nonanalogous Art Cannot Form the Basis of a Rejection

Karube and Jaeger cannot properly be combined to yield the claimed invention because a camera, designed to function from a stationary position, is not analogous with an input device, designed to always be movable. Jaeger is likewise nonanalogous to the claimed invention. The standard for determining whether art is nonanalogous is as follows:

The determination that a reference is from a nonanalogous is therefore twofold. First we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

In re Wood, 599 F.2d 1032, 202 USPQ 171 (CCPA 1979).

Jaeger does not pass either test with respect to Karube or the claimed invention. Jaeger is directed to a magnetic and mechanical device that enables a manual input device to freely slide across a screen during operation. The claimed invention is directed to a camera that is to remain stationary during operation. No movement is anticipated or contemplated with the camera. A device to slidably move across a screen requires a supporting structural assembly which is evidence of a different function to address a different problem. Accordingly, Jaeger is neither in the field of endeavor, nor pertinent to the problem addressed by Applicant's invention, Jaeger is inapposite to Applicant's invention and cannot properly be the basis for a rejection under 35 U.S. C. § 103(a).

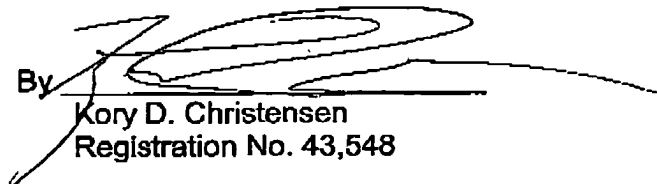
In view of the foregoing, independent claims 1, 19, 20, and 38 are patentably distinct. As the remaining depending claims 3, 4, 10, 13-16, 22, 23, 29, and 32-35

each include the limitations of their respective independent claim, they likewise are patentably distinct. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Digeo, Inc.

By



Kory D. Christensen
Registration No. 43,548

STOEL RIVES LLP
One Utah Center Suite 1100
201 S Main Street
Salt Lake City, UT 84111-4904
Telephone: (801) 328-3131
Facsimile: (801) 578-6999